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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,617	07/30/2001	Michael B. Allen	File 10489	3190
8156	7590	03/09/2005	EXAMINER	
JOHN P. O'BANION O'BANION & RITCHEY LLP 400 CAPITOL MALL SUITE 1550 SACRAMENTO, CA 95814			MACKEY, JAMES P	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,617

Applicant(s)

ALLEN, MICHAEL B.

Examiner

James Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004 and 07 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12-19, 23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 14 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8, 12, 13, 15-17, 19, 23, 25-28 and 31 is/are rejected.
- 7) ☒ Claim(s) 29 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/7/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 3, 7, 14 and 18 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 29 March 2004.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not describe the apparatus including a side wall form extending downstream from the slip form, as claimed in claim 31, and also including a second roller opposite to the impression roller, as claimed in claim 29 (note that claim 31 depends from claim 29).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12, 27 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the wet concrete wall" in line 7. There is insufficient antecedent basis for this limitation in the claim.

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Claim 27 recites the limitation "the wet concrete wall" in lines 11-12. There is insufficient antecedent basis for this limitation in the claim.

Claim 31 recites the limitation "said slip form assembly" in line 3. There is insufficient antecedent basis for this limitation in the claim.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 12, 13 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggleton et al. (U.S. Patent 6,293,728; Figure 14; col. 7, line 65 through col. 8, line 21).

Eggleton et al. teach a patterning apparatus comprising a cylindrical impression roller 156 having an axis of rotation and an outer periphery impressed with a three-dimensional pattern; means 155 for supporting said roller for rotation about said axis with said outer periphery being partially depressed into an exposed top side surface of extruded wet concrete (which is broadly construed to comprise a "wall") emerging from a slip form 24, the roller axis being maintained substantially parallel to the exposed surface; and means 151, 154 for supporting the roller for advancement along the extruded concrete.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 5, 16, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleton et al. (U.S. Patent 6,293,728; Figure 14; col. 7, line 65 through col. 8, line 21).

Eggleton et al. teach the apparatus substantially as claimed, as described above, wherein the support means include first and second bifurcated arms 155 rotatably attached to first and second ends of the roller, the arms extending from a support frame 151 coupled to the slip form machine 20. Eggleton et al. do not explicitly disclose that the arms are upper and lower arms rotatably attached to upper and lower ends of the roller. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Eggleton et al. by providing the impression roller in a vertical orientation such that the first and second support arms are upper and lower arms rotatably attached to upper and lower ends of the roller, in order to impress a pattern onto an exposed vertical surface of the extruded concrete. Note that it has generally been recognized that to shift location of parts when the operation of the device is not otherwise changed is within the level of ordinary skill in the art, *In re Japikse*, 86 USPQ 70, and such is the case here, where a skilled artisan would have readily recognized that any exposed surface of the extruded concrete may be patterned by appropriate orientation of the impression roller.

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11. Claims 4, 15, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleton et al. (U.S. Patent 6,293,728; Figure 14; col. 7, line 65 through col. 8, line 21) in view of Jordan (U.S. Patent 5,033,906; col. 5, lines 54-56) and any one of Nauta et al. (U.S. Patent 4,211,743), Nauta (U.S. Patent 3,893,795) and Nauta (U.S. Patent 3,605,194).

Eggleton et al. disclose the apparatus substantially as claimed, except for the outer periphery of the roller being made from a curable silicon. Jordan discloses a patterning roller having an outer periphery with a three dimensional pattern for impressing a pattern onto a surface of wet concrete, wherein the roller may be formed of synthetic resin material (col. 5, lines 54-56). Each of Nauta et al. '743, Nauta '795 and Nauta '194 discloses an impression patterning roller having a silicone rubber outer periphery with a three dimensional pattern surrounding a rigid core. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Eggleton et al. by providing the outer periphery of the impression roller of a synthetic resin material, as suggested by Jordan, since such was an equivalent impression roller to the impression roller of Eggleton et al., and obvious to provide the synthetic resin material as curable silicone rubber surrounding a rigid core, as disclosed in any one of Nauta et al. '743, Nauta '795 and Nauta '194, since such was a conventional impression patterning roller having a durable patterned outer surface layer.

12. Claims 6, 8, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleton et al. (U.S. Patent 6,293,728; Figure 14; col. 7, line 65 through col. 8, line 21) in view of any one of Jordan (U.S. Patent 5,033,906; col. 5, lines 27+), Meirick (U.S. Patent 5,421,670; roll holder 44) and Moorhead (U.S. Patent 3,832,079; the abstract).

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Eggleton et al. disclose the apparatus substantially as claimed, except for means for applying a release agent on the wet concrete before it comes into contact with the outer periphery of the impression roller, the release agent being a thin plastic film. Each of Jordan, Meirick and Moorhead discloses an impression roller having a patterned outer surface for impressing a pattern onto the surface of wet concrete, and further including means for applying a thin plastic film release agent onto the wet concrete before it comes into contact with the outer periphery of the impression roller. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Eggleton et al. by providing means for applying a thin plastic film release agent onto the wet concrete before it comes into contact with the outer periphery of the impression roller, as disclosed in any one of Jordan, Meirick and Moorhead, in order to avoid fouling of the surface of the impression roller.

13. Claims 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach or fairly suggest a second roller displaced to engage a second exposed side surface opposite the first exposed side surface which is engaged by the impression roller, as is claimed in claim 29. The prior art of record does not teach or fairly suggest a side wall form extending downstream from the slip form assembly, the side wall form

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being adjacent to a second exposed side surface opposite the first exposed side surface which is engaged by the impression roller, as is claimed in claim 31.

14. Applicant's arguments filed 22 July 2004 have been fully considered but they are not persuasive.

Applicant argues that Eggleton et al. do not disclose formation of a slip form wall; however, to the extent that such relates to the structure of the claimed apparatus (note that, in at least claim 1, the slip form itself is not claimed), Eggleton et al. clearly teach a slip form apparatus, and the extruded concrete emerging from the slip form may be broadly construed as a "wall" (an upright structure serving to enclose, divide or protect an area).

Applicant argues that Eggleton et al. do not disclose impressing a pattern by the impression roller onto a side surface of the extruded concrete; however, Eggleton et al. clearly teach that the impression roller engages the exposed **top side** surface of the extruded concrete.

Applicant argues that a skilled artisan would not have been motivated to modify Eggleton et al. by providing upper and lower support arms for the impression roller (in effect, providing a vertical orientation to the impression roller); however, a skilled artisan would have been motivated to modify Eggleton et al. in such a manner in order to impress a pattern into any of the exposed surfaces of the extruded concrete, including either of the vertical exposed surfaces, and thereby apply decorative features to any of the visible surfaces of the extruded concrete.

Applicant further argues that Eggleton et al. disclose structure to locate a channel in one of the vertical side surfaces of the extruded concrete, which teaches away from orienting the impression roller to imprint a pattern onto this vertical side surface; however, no reason is seen why this vertical side surface may not include both decorative patterning as well as the channel for an

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irrigation/lighting line, but notwithstanding, the opposite exposed vertical side surface of the extruded concrete disclosed in Eggleton et al. does not include such a channel.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

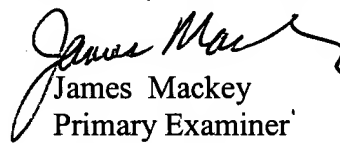
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ben Utech can be reached on 571-272-1137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James Mackey
Primary Examiner
Art Unit 1722

3/7/05

jpm
March 7, 2005